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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,080

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David Lawrence

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EXAMINER

FERTIG, BRIAN E

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/633,080	<b>Applicant(s)</b> LAWRENCE, DAVID	
	<b>Examiner</b> BRIAN FERTIG	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 23, 27-29 and 34-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24-26 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/16/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to applicant's filing of 4/22/2008. Applicant has elected Species D, fig 6 and identified claims 1-22, 24-26, and 30-33 as being associated with this Species and withdrawn claims 23, 27-29, 34-38. Claims 1-22, 24-26, and 30-33 are examined below.

#### ***Election/Restrictions***

1. Applicant's election without traverse of claims 23, 27-29, 34-38 in the reply filed on 4/22/2008 is acknowledged.

#### ***Claim Rejections - 35 USC § 112***

2. Claim 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 depends from itself, thereby causing it to be indefinite. For the purposes of examination below, it is assumed that claim 20 is meant to depend on claim 19.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 17-22, 24-26, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,680,305 to Apgar in view of Richard N. Clarke's

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article SICs as a Definition of Economic Markets, published in The Journal of Business, vol 62, No 1, Jan 1989, p 17-31 (Clarke).

With respect to claim 1

Apgar teaches:

A computer-implemented method for managing risk related to a construction industry, the method comprising:

indicating in a computer system that an entity is a construction industry entity according to the entity's engagement in at least one of: design, building, manufacture, repair and maintenance, of one or more man made structures (see col 6, lines 20-32, note that SIC information is implicitly input into the system, since it is used as a basis for determining the similarity between business entities, see also col 3, lines 45-67 teaching that property/developers and managers and architects are preferred users of the system);

gathering data into the computer system generally related to one or more construction industry entities (i.e. building database of information about real estate including utilization information usage data, and cost data, see col 6, lines 15-21, note that the data specifically identifies rental as a type of usage, suggesting that the construction entity about whom the data is gathered is a landlord. Landlords are engaged in the repair and maintenance of their properties);

receiving data into the computer system descriptive of details of a financial transaction involving a construction industry entity, wherein the data received comprises identification data for at least one construction industry entity (i.e. receiving into the system the utilization, usage, and cost data requirements of the Business Entity considering the selected use of a property, see col 6, lines 33-35);

structuring the gathered data and the data relating details of the financial transaction according to risk quotient criteria (see col 6, lines 12-22, note that the gathered data is structured in a database);

calculating a risk quotient by referencing the structured data (i.e. calculating a score evaluating the real estate, see col 6, lines 40-43 and 63-67, note that the score explicitly includes a risk component); and

generating a report comprising the risk quotient and at least some of the structured data referenced to calculate the risk quotient (see col 6, lines 43-45, and col 21 line 64- col 26, line 65, note that SCORE DATA and REAL ESTATE DATA are both included in the report).

Apgar does not explicitly teach the relationship between SIC and the entity's

engagement in at least one of: design, building, manufacture, repair and maintenance, of one or more man made structures

Clarke teaches that SIC codes are used to identify an entity's engagement in various construction industry aspects, such as Construction (1500-1999), see page 24.

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It would have been obvious to one having ordinary skill in the art to have provided Apgar with the SIC identification of a Construction Industry Entity in order to have allowed for the identification of businesses having similar products or manufacturing methods as explicitly taught by Apgar (see col 6, lines 27-33) and Clarke (see page 17)

With respect to claim 2

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the financial transaction comprises a financial investment in at least one of: a construction industry entity and a construction industry project (note that the Business Entity considering the selected use of a property may be seeking a Landlord form whom to rent space, see Apgar, col 3, lines 45-67 and col 6, line 20).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 3

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the financial transaction comprises engaging the services of a construction industry entity (see Apgar col 3, lines 36-67, note that renters are disclosed who implicitly see the services of Landlords who repair and maintain properties).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 4

Apgar in view of Clarke teaches:

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The method of claim 1 (see rejection of claim 1 above) wherein the risk quotient comprises an indication of a cost to defend an adverse position (see Apgar col 13, lines 29-44, note that the Risk portion of the score comprises financial exposure risk of the Business Entity in owning or leasing the real estate in combination with litigious risks such as environmental hazards and EPA scrutiny).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 5

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the risk quotient comprises an indication an amount of reputational risk (see Apgar col 13, lines 29-44, note that the Risk portion of the score comprises Market exposure which fairly suggests reputational risk, since a persons reputation is an important factor factor within the market as evidenced by the value of securing and protecting Trademarks).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 6

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the risk quotient comprises an indication of an amount of regulatory risk (see Apgar col 13, lines 29-44, note that the Risk portion of the score comprises environmental exposure and specifically recites EPA registered hazards. This suggests regulatory risk in

so far as the Business Entity would be under the scrutiny of the EPA with respect to issues such as abatement of the hazards).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 7

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the risk quotient comprises an indication of an amount of legal risk (see Apgar, col 13, lines 29-44, note that the Risk portion of the score comprises litigious risks such as environmental hazards and EPA scrutiny. This suggests an amount of legal risk in so far as both the EPA and public use the litigation to enforce hazardous materials laws and to receive compensation based on injuries suffered from exposure to these materials. Note further that hazardous materials also suggest legal exposure via doctrines such as *res ipsa loquitur*)

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 8

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the risk quotient comprises an indication of an amount of risk associated with monetary costs related to potential fines (see Apgar col 13, lines 29-44, note that the Risk portion of the score comprises financial exposure risk of the Business Entity in owning or leasing the real estate in combination with environmental hazards and EPA scrutiny, thus suggesting exposure to potential fines).



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(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 9

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the gathered data comprises data descriptive of one or more world events which is received via a news feed (see Apgar col 6, lines 46-53, note that data related to space and cost utilization are gathered from news feeds such as Dun & Bradstreet, TRW, or Equifax, these are world events in so far as the space and cost information within real-estate markets is subject to change and is important to those involved in that industry).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 10

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the gathered data comprises at least one government advisory (see Apgar col 6, lines 23-62, note that SIC codes are gathered. SIC codes suggest government advisories in so far as they are a taxonomy used and promulgated by the Bureau of the Census as taught by Clarke, see pg 17).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 11

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein calculating the risk quotient criteria comprises a value determined by the steps of:

associating a numerical weight with each of a plurality of risk variables (see Apgar col 14, lines 1-67, note that, at least, steps 5,6,8, and 9 assign a numeric weight);

associating one or more of the risk variables with the data descriptive of details of a financial transaction (see Apgar col 14, lines 1-67, note that, at least, steps 5, 6, 8, and 9 associate the risk variables with the data descriptive details in so far as they assign a numeric weight based on the risk variables association with a criteria to a threshold or distance);

determining a numerical value based upon the content of the data descriptive of details of a financial transaction associated with the one or more risk variables (see Apgar col 14, lines 1-67, note that, at least, steps 5, 6, 8, and 9 determine a numeric weight with respect to the risk variables association with a criteria to a threshold or distance, i.e. smaller than a threshold); and

multiplying the numerical value based upon the content times the numerical weight associated with each of the risk variables associated with the data descriptive of details of a financial transaction (see Apgar, col 15, lines 1-23, note that at least step 22 teaches that the risk factors are adjusted by weighting factors).

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(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 12

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) additionally comprising the steps of presenting the report as evidence of due diligence to at least one of: a regulatory body, a shareholder and a news media (see Apgar, col 3, lines 36-67, note that the reports are used by Customers to make unbiased real estate decisions. This teaching suggests using the reports of evidence of due diligence since the process due diligence is one that involves providing justification supporting a decision. Note further, that Apgar teaches the utility of these reports to regulatory bodies, such as government, and to investors).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 13

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) additionally comprising the step of generating a suggested action based upon the risk quotient and at least some of the structured data referenced to calculate the risk quotient (see col 23, lines 10-17, note that the total score is presented. Note this is a suggested action in so far as the properties with the highest score most closely meet the customer's expressed needs and are thus suggesting that these are the properties most relevant to customer's decision making).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

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With respect to claim 14

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the data gathered comprises data relating to one or more personnel employed by a construction industry entity (see Apgar, col 22, lines 26-27, note that contact name and title of the principal is included in the report. It is, therefore, implicit that this information was gathered).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 17

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) but does not explicitly teach wherein the report comprises a record of conviction of an employee or owner of a construction industry facility.

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 18

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above)) wherein the report comprises data descriptive of fines levied against a construction industry facility or complaints filed against the facility (note that data descriptive of fines is non-functional descriptive material that has been considered but not given any patentable weight and therefore fails to distinguish over the report taught by Apgar, see col 21, lines 65-67).

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(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 19

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the report comprises one or more sources of the gathered data (see Apgar par 6, lines 10-62, note that the report comprises information collected from individual business entities and from business databases).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 20

Apgar in view of Clarke teaches:

The method of claim 20 (assumed to be claim 19, see USC 112 2<sup>nd</sup> paragraph based rejection above) wherein the source comprises an investigation firm (See Apgar par 6, lines 51-56, note D&B, TRW, and Equifax).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 21

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) additionally comprising the step of transmitting an image of an informational artifact comprising data associated with the financial transaction (see Apgar col 6, lines 33-45, note that utilization information and values are communicated via a computer line. These are images of information artifacts in so far as they contain information that can be interpreted into a humanly ascertainable form. Note that a numerical

representation can be interpreted such that a human could ascertain its meaning,  
i.e. in the context of the report).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 22

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein report does not  
comprise any content created or developed by a provider of the system  
implementing the method for managing risk associated with construction  
industry. (see Apgar col 6, lines 10-62, note that the system collects and  
aggregates information provided by business entities, business databases, etc)

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 24

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the data is  
gathered into a risk management clearinghouse (see Apgar col 6, lines 10-67,  
note that the data is gathered into a computerized system for managing risks and  
associating information with a risk subject).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 25

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein the data  
descriptive of details of a financial transaction is received by a proprietary risk

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management system (see Apgar col 6, lines 10-67, note that the information is entered into the system, which is proprietary in so far as it is the subject of a Patent).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 26

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein at least one of the gathered data and the data descriptive of details of a financial transaction; comprise data provided by a recipient of construction industry services (see Apgar, see col 6, lines 33-35, note that the Business Entity considering the selected use of a property enters the details in order to search to for services to be received).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 30

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein structuring the gathered data and the data relating details of the financial transaction according to risk quotient criteria comprises processes based upon Boolean logic (see Apgar col 14, lines 1-67, note that, at least, steps 5 and 6 are based upon Boolean logic in so far as they test for greater than or smaller conditions).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 31

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) wherein structuring the gathered data and the data relating details of the financial transaction according to risk quotient criteria comprises relevance ranking (See Apgar col 15, lines 20-23, note that at least steps 22 and 23 comprise a relevance ranking in so far as the indicators are adjusted by weighting factors.)

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 32

See rationale supporting the rejection of claim 1 above. Note that Apgar teaches a computer server and implies executable software, see col 6, lines 33-45 and fig 1.

With respect to claim 33

See rationale supporting the rejection of claim 1 above.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Apgar in view of Clarke and in further view of EPA Asbestos Ban: Clarification May 18, 1999, retrieved from <http://www.epa.gov/asbestos/pubs/asbbans2.pdf>, May 29, 2008 (EPA).

With respect to claim 15

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above) additionally comprising the steps of: transmitting a description of the associated statute and the report (see Apgar col 25, lines 15-18, note that report contains explanatory definitions



for items whose meanings might not be self-evident. This suggests transmitting a description of the associated statute when read in combination with EPA, below.).

Apgar in view of Clarke does not explicitly teach:

associating one or more statutes or regulations with the financial transaction.

EPA teaches:

associating one or more statutes or regulations with the financial transaction (see Introduction, note that asbestos regulation falls under Federal Reeregulations including the Clean Air Act and Toxic Substances Control Act)

It would have been obvious to one having ordinary skill in the art to have provided the Asbestos risks of Apgar in view of Clarke with the teaching of the association of statutes and regulations related to Asbestos taught by EPA in order to inform users as to the current statutory treatment of Asbestos products and uses as taught explicitly by EPA (see Introduction). It would have been further obvious to report and describe these statutes in the Terms and Definitions section of Apgar in order to have explain terms and meanings which might not be self-evident to the customer as taught explicitly by Apgar (see col 25, lines 15-18)

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Apgar in view of Clarke and in further view of The Federal Trade Commission's article Fair Credit Reporting, March 1999, retrieved from [http://www.pueblo.gsa.gov/cic\\_text/money/fair-credit/fair-crd.htm](http://www.pueblo.gsa.gov/cic_text/money/fair-credit/fair-crd.htm), May 29, 2008 (FTC).

With respect to claim 16

Apgar in view of Clarke teaches:

The method of claim 1 (see rejection of claim 1 above), but does not explicitly teach additionally comprising the step of transmitting the report to a subscriber, wherein transmission of the report is conditioned upon receipt of a contractual obligation not to use contents of the report for any purpose covered by the Fair Credit Reporting Act.

FTC teaches:

additionally comprising the step of transmitting the report to a subscriber, wherein transmission of the report is conditioned upon receipt of a contractual obligation not to use contents of the report for any purpose covered by the Fair Credit Reporting Act (see page 1, note that Consumer Reporting Agencies are subject to additional requirements under the FCRA. This teaching suggests conditioning the report on a contractual obligation not to use the report for purposes of the FCRA in order to avoid incurring the additional requirements imposed by the FCRA).

It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have provided Apgar in view of Clarke with the contractual obligation suggested by FTC in order to avoid the additional requirements imposed to by the FCRA as taught implicitly by FTC since additional regulatory requirements are burdensome and can add additional legal risk and complexity to the operation of the invention.

### **Inquiry**

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.F./

/Mary Cheung/

Primary Examiner, Art Unit 3694